

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Eric JACQUINOT et al

Art Unit: 1765

Application No.: 09/427,675

Examiner: D. Deo

Filed: October 27, 1999

Washington, D.C.

For: NEW ABRASIVE COMPOSITION FOR THE INTEGRATED CIRCUITS ELECTRONICS...

Atty.'s Docket: JACQUINOT=7

Conf. No.: 3607

Date: April 26, 2004

Mail Stop **Appeal Brief- Patents**
THE COMMISSIONER OF PATENTS AND TRADEMARKS
Arlington, VA 22202

Sir:

Transmitted herewith is a ☒ **Reply BRIEF ON BEHALF OF APPELLANT** in the above-identified application.

☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

☐ Fee for Filing a Brief in Support of an Appeal, paid on April 26, 2004.

The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 42	\$
+ 135	\$
ADDITIONAL FEE TOTAL	
	\$

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 84	\$
+ 270	\$
OR TOTAL	
	\$

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

☐ First - \$ 55.00
☐ Second - \$ 200.00
☐ Third - \$ 460.00
☐ Fourth - \$ 720.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

☐ First - \$ 110.00
☐ Second - \$ 400.00
☐ Third - \$ 920.00
☐ Fourth - \$ 1440.00

Month After Time Period Set

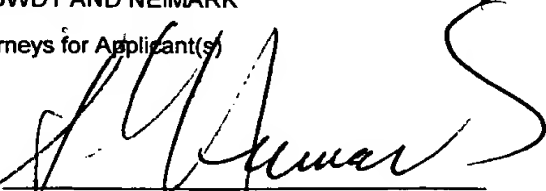
☐ Less fees (\$) already paid for month(s) extension of time on

☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	Art Unit: 1765
)	
Eric JACQUINOT et al)	Examiner: Duy DEO
)	
Appln. No.: 09/427,675)	Washington, D.C.
)	
Date Filed: October 27, 1999)	Confirmation No.: 3607
)	
For: NEW ABRASIVE COMPOSITION)	August 12, 2004
FOR THE INTEGRATED)	
CIRCUITS ELECTRONICS...)	ATTY.'S DOCKET: JACQUINOT=7

REPLY BRIEF ON BEHALF OF APPELLANTS

Honorable Commissioner for Patents
2011 South Clark Place
Customer Window,
Mail Stop **Appeal Brief-Patents**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This is a Reply Brief under 37 CFR 1.193(b)(1)
replying to the Examiner's Answer mailed June 17, 2004.

1. Appellants note that the Examiner has accepted Appellants' Summary of the Invention at pages 2-4 of the Appellants' Main Brief, and therefore the Examiner accepts the statement of improved results achieved by the present invention as stated in such Summary portion of Appellants' Main Brief.

2. In the middle paragraph on page 3 of the Examiner's Answer, the Examiner implies or suggests that there is some relationship between improving "within-wafer-nonuniformity (WIWNU) of the wafers" and improved selectivity achieved by the present invention. However, the Examiner has not established any basis for his conclusion, and Appellants respectfully submit that such conclusion stated by the Examiner is only based on speculation.

Appellants' Main Brief points out very clearly that Grover teaches that it is the "unique chemistry" which provides improved selectivity in Grover, noting for example pages 10, 11 and 17 of Appellants' Main Brief, as well as the top paragraph on page 20 of Appellants' Main Brief. Indeed, Grover is correct as proven by experiments conducted by Dr. Jacquinot and which appear in his Declaration (see, e.g., bottom paragraph on page 20 of Appellants' Main Brief).

Contrary to the argument of the Examiner in the middle paragraph on page 3 of the Examiner's Answer, Grover does not teach any relationship between the presence of surfactant and improved selectivity.

3. In the first full paragraph under the heading "Response to Argument" near the top of page 4 of the

Examiner's Answer, and again in the paragraph spanning pages 4 and 5, the Examiner jumps to another conclusion, ignoring the fact that Grover provides no substantial or meaningful motive or incentive for incorporating surfactant. But this in any event is not a main argument of Appellants'.

Instead, Appellants asked (and continue to ask) the question why would the person of ordinary skill in the art seeking a solution to problems faced by Appellants even consider Jacquinet when Grover already teaches a solution to the same problem by doing something substantially different, i.e. proceeding with Grover's "unique chemistry". The Examiner provides no answer to this question, and no rebuttal to Appellants' argument in this regard, e.g. that following Grover leads in a different direction away from Appellant's claimed invention.

4. In the second paragraph under the heading "Response to Argument" on page 4 of the Examiner's Answer, the Examiner sets up a straw man to knock him down. It should go without saying the references must be discussed individually to understand what each teaches individually, prior to the discussion of whether or not their combination would have been obvious to the person of ordinary skill in the art at the time the claimed invention was made.

Appellants both discussed the references individually and the nonobviousness of their proposed combination.

5. The Examiner's comments in the first full paragraph on page 5 of the Examiner's Answer makes no sense to Appellants, but Appellants will try to answer based on what the Examiner seems to be saying. As regards the Examiner's "first of all" comment, i.e. "the reason for adding a surfactant [in Grover] is not the selectivity", this supports Appellants' position, i.e. here the Examiner appears to agree that adding surfactant has no relationship to improved selectivity.

As regards the Examiner's "second of all" comment, the improved selectivity inherently obtained according to Appellants' claimed process is part of Appellants' invention "as a whole" and need not be claimed, e.g. *In re Estes*, 164 USPQ 519, 521 (CCPA 1970). Also see *In re Ward*, 141 USPQ 227, 228 (CCPA 1964); *Ex parte Tiemann*, 157 USPQ 158, 160 (POBA 1967); *In re Wright*, 6 USPQ2d 1959, 1962 (Fed Cir 1988).

Improved selectivity is an inherent feature of Appellants' claimed subject matter, and is part of Appellant's invention "as a whole".

6. In the bottom paragraph on page 5 of the Examiner's answer, the Examiner attacks Dr. Jacquinot's Declaration, so as to mostly brush it aside. For example, the Examiner chooses to brush aside or ignore the improved selectivity established by Dr. Jacquinot's Declaration. Indeed, the Examiner admits that "the Declaration shows a better polishing selectivity between the TEOS and the nitride..." but says that he may ignore this because "the claims do not have or include neither [sic] the selectivity nor the slurry stability." But, again, selectivity need not be claimed because it is part of Appellants' invention as a whole.

Dr. Jacquinot's test results as shown in his Declaration provide evidence of various kinds, these being briefly discussed for example at pages 20-23 of Appellants' Main Brief, relied upon by Appellants. For example, Dr. Jacquinot's Declaration shows the relative unimportance of the surfactant in the Grover slurry. It further shows a vast increase when the surfactant is added to the slurry of the Jacquinot primary reference. It also shows that the presence of surfactant in the Grover composition does not increase the stability of that composition, whereby real world experience with Grover would tell those of ordinary skill in the art that there is no meaningful advantage to be

achieved by using surfactant in the Grover composition, whatever small improvement might be achieved being offset by extra material and processing costs.

Moreover, insofar as Dr. Jacquinot's Declaration is concerned, it is **evidence**. The law is clear that no evidence should be ignored, e.g. *In re Khelghatian*, 150 USPQ 661, 663, footnote 2 (CCPA 1966). Moreover, evidence of nonobviousness may be indirect, e.g. *In re Blondel et al*, 182 USPQ 294, 198 (CCPA 1974). The Examiner improperly disregarded Dr. Jacquinot's Declaration.

7. The Examiner has not answered or rebutted many of Appellants' arguments set forth in Appellants' Main Brief. As the Examiner has not answered or rebutted these points, it must be assumed that the Examiner cannot rebut same and has no answer for same.

For example, Grover requires features which are not incorporated into the present invention. Grover therefore teaches **away from** the present invention and any reliance on Grover must result in subject matter which is quite different from what Appellants ' claims (pages 14-18 of Appellants' main Brief).

Wherefore the Examiner has not met his burden in establishing a *prima facie* case of obviousness; and the

In re of Appln. No. 09/427,675

Examiner has not considered all the evidence, wherefore the rejection should be reversed. Such is again respectfully prayed.

Respectfully submitted,

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